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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,838	01/19/2005	Frank Haase	TS8578US	2392

7590
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Intellectual Property
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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1797

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04/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/521,838	Applicant(s) HAASE, FRANK	
	Examiner Ellen M. McAvoy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>28 January 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jahier et al (EP 0 789 203 A1) in combination with Berlowitz et al (5,689,031) or Wittenbrink et al (6,296,757).

Applicant's arguments filed 28 January 2009 have been fully considered but they are not persuasive. As previously set forth, Jahier et al ["Jahier"] disclose a gas condensing boiler which meets the limitations of the condensing boiler of the claims as set forth in the specification on page 1. Applicant teaches in the specification that normally condensing boilers use natural gas as fuel which may not be available in all areas where no natural gas grid is present. Applicant's claimed invention differs from Jahier by using a Fischer-Tropsch derived fuel as a substitute for natural gas. However, as evidenced by Berlowitz et al ["Berlowitz"] and Wittenbrink et al ["Wittenbrink"], such Fischer-Tropsch derived fuels are conventional in the art.

Berlowitz discloses a Fischer-Tropsch derived diesel fuel which boils in the range of 250° – 700°F, contains at least 95 wt.% paraffins, has an iso- to normal paraffin ratio of about 0.3 to 3.0, and a sulfur content and nitrogen content of less than 50 ppm, preferably nil. The Fischer-Tropsch process produces a distillate having virtually no aromatic compounds. See column 4, lines 6-67. Berlowitz teaches that typically petroleum derived distillates are not clean in that they contain significant amounts of sulfur, nitrogen and aromatics, and that Fischer-

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Tropsch derived distillates are “clean” in that they contain very low amounts of sulfur, nitrogen and aromatics. Wittenbrink discloses synthetic diesel fuels or blending stocks for diesel fuels and processes for the preparation from a Fischer-Tropsch wax. The synthetic fuels disclosed in Wittenbrink boil in the range of 250° – 700°F, contains at least 95 wt.% paraffins, has an iso- to normal paraffin ratio of about 0.3 to 3.0, and a sulfur content and nitrogen content of less than 50 ppm, and preferably nil. The Fischer-Tropsch process produces distillates containing virtually no aromatic compounds. See column 3, lines 47 to column 4. Wittenbrink also teaches that such “clean” distillates are, or likely will be, in great demand as diesel fuel or in blending diesel fuel. Thus having the prior art references before the inventor at the time the invention was made it would have been obvious to have used a conventional fuel such as the clean distillate fuel taught by either Berlowitz or Wittenbrink in the condensing boiler of Jahier. As recently instructed by the Supreme Court, when a claim defines a combination of elements known in the prior art, the combination must do more than yield a predictable result. *KSR Int’l. Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740 (2007).

In response, applicant canceled claims 1-10 drawn to a process for operating a condensing boiler with a Fischer-Tropsch fuel and presented new claims drawn to a process for reducing corrosion in a condensing boiler which burns a liquid fuel comprising a Fischer-Tropsch fuel. Applicant argues that the examiner has not pointed to a teaching or suggestion in any of the cited references of a process for reducing corrosion in a condensing boiler burning liquid fuel. This is not deemed to be persuasive because the process of the claims comprises the step of supplying a liquid fuel comprising a Fischer-Tropsch derived fuel to a condensing boiler. The language “for reducing corrosion in a condensing boiler burning fuel” has not been given

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patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Further, as set forth above, Fischer-Tropsch derived fuels are considered to be “clean” distillates that contain little or no sulfur, nitrogen and aromatics; as opposed to petroleum derived distillates which are not clean in that they typically contain significant amounts of sulfur, nitrogen and aromatics. Thus cleaner burning fuels such as Fischer-Tropsch derived fuels are expected to result in less accumulation of deposits which can result in corrosion on the metal surfaces.

Applicant argues that the examiner certainly has not pointed to a teaching of suggestion that “the liquid condensate” produced burning fuel comprising Fischer-Tropsch derived fuel in a condensing boiler would comprise “a reduced iron content (or nickel content) compared to the iron (nickel) content produced by combusting an industrial gas oil fuel using the same condensing boiler under the same conditions”. This is not deemed to be persuasive because cleaner Fischer-Tropsch derived fuels are expected to result in cleaner burning which means less deposits. Apparently iron and nickel are present in industrial gas oil fuels and the resulting liquid condensate, and Fischer-Tropsch derived fuels do not contain any of the heavy metals iron and nickel.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ellen M McAvoy/
Primary Examiner
Art Unit 1797

EMcAvoy
April 16, 2009